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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,536	04/09/2001	Shelton Louie	1205-007/JRD	8460

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EXAMINER

JAKETIC, BRYAN J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,536

Applicant(s)

LOUIE ET AL.

Examiner

Bryan Jaketic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 16 is objected to because of the following informalities: "presences" in line 3 of the claim should presumably be --presence--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-7 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of McCullough et al. Denenberg et al disclose a method for tracking prescription orders through a retail pharmacy having a plurality of spaced apart

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locations comprising the steps of receiving the prescription order at a first location (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38); manually storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); automatically detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col. 6, lines 39-47); and displaying the location on a computer display that is viewable by pharmacy workers (col. 13, lines 27-47).

Denenberg et al further disclose the steps of automatically collecting timing information, storing the timing information, compiling workflow information based on the timing information and determining an estimated completion time (col. 16, lines 1-43).

Denenberg et al fail to teach a tag that is detachably secure to the prescription order or that is rigidly secured to the prescription. However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg et al also fail to disclose a tag reader for each cubby. However, Denenberg et al disclose a tag reader (50) for the entire station, and an additional

sensor (23) for each cubby that detects when a prescription is placed in the cubby or moved away. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a tag reader in each cubby, to reduce the workload of the worker and reduce error.

Denenberg does not teach that the cubby tag readers are hand-held and manually operated. However, hand-held and manually operated tag readers are common in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ hand-held and manually operated tag readers so that employees can be sure that the tags have been properly read.

Denenberg does not teach that prescription orders are tagged with a tag having the same identifier, wherein the identifier is unique to the customer nor does Denenberg teach the step of displaying status of prescription orders on a customer display. McCullough et al teach a paging system, wherein a unique customer identifier is used to identify prescriptions (col. 6, lines 6-52). McCullough et al further teach a customer display (108) that displays the unique customer code and notifies the customer of the order status (see col. 3, lines 31-38; and col. 6, line 53 through col. 7, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of McCullough et al with the invention of Denenberg to help a customer retrieve his prescription as quickly as possible.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al and McCullough et al as applied to claim 5 above, and further in view of Engellenner et al. Denenberg et al and McCullough et al disclose all of the limitations

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of the claims except for an electromagnetic tag and tag reader. Engellenner discloses an electromagnetic tag and tag reader (see Fig. 1) for locating items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner with the combination of Denenberg et al and McCullough et al, because the tag reader of Engellenner can interrogate a larger spatial region.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al and McCullough et al as applied to claim 19 above, and further in view of Yehuda. Denenberg et al and McCullough et al disclose all of the limitation of the claim except for a display of estimated completion. Yehuda discloses a display (16) that shows an estimated time until completion (see col. 4, lines 44-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Yehuda with the combination of Denenberg et al and McCullough et al to help the customer quickly complete his transaction.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fuchs et al, McCay et al, and Brook et al disclose methods of tracking items in a hospital. Williams et al, Ahlin et al, Pilarczyk, Boyer et al (US 6,202,923), and Boyer et al (US 5907,493) disclose pharmaceutical management systems. Nellhaus discloses a method of barcoding drugs. Phoon et al disclose an

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apparatus for storing and tracking usage of drugs. Brown discloses a method for inventorying substances.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj



11/6/03